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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,216	09/07/2000	Jean-Paul Cholon	END9-2000-0105US1	1339
44755	7590	11/30/2004	EXAMINER	
SHELLEY M. BECKSTRAND 61 GLENMONT ROAD WOODLAWN, VA 24381			O'CONNOR, GERALD J	
		ART UNIT		PAPER NUMBER
				3627

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/657,216	Chollon et al.	
	<b>Examiner</b>	<b>Art Unit</b>	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extension of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on November 2, 2004 (Amdt) and December 6, 2004 (RCE).
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 14-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on June 25, 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 2, 2004 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the amendment and arguments filed by applicant on November 2, 2004 in reply to the previous Office action, mailed September 3, 2004.

3. The amendment of claims 1, 14, and 15 by applicant on November 2, 2004 is hereby acknowledged.

### ***Claim Rejections - 35 USC § 101***

4. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3, 20, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-3, 20, and 21 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Additionally, method claims that fail to require the use of any technology, such as claims 1-3, 20, and 21, are considered non-statutory under § 101, for failing to fall within the technological arts. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation in the body of the claim is required to recite the use of some technology, such as either a computer, *per se*, or else some other computer element that would inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

6. Claims 14, 16, 22, and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14, 16, 22, and 23 are drawn merely to the production and/or manipulation of non-functional descriptive material, therefore effecting no “useful, concrete, and tangible result.” It has been held that such claims, even if the non-functional descriptive material is claimed in combination with a computer-readable medium, are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea. *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

7. Claims 15 and 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15 and 17-19 are drawn to a computer program *per se*. Therefore, claims 15 and 17-19 are drawn merely to *disembodied* functional descriptive material, therefore effecting no “useful, concrete, and tangible result.” It has been held that such claims are considered to comprise non-statutory subject matter, amounting to simply an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 and 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al. (US 5,758,327).

Gardner et al. disclose a method for creating a valid chart of accounts from which an administrator of a local enterprise can facilitate and enable a requisitioner to select a valid account, comprising the steps of: establishing a communication link 30 with an external enterprise catalog system 12; transmitting 36 from the enterprise catalog system 12 a chart of

accounts to a requisition catalog system database 10, it being deemed inherent that the format on the local enterprise system would be specified by the local system; selecting from the requisition catalog system database 10 valid accounts with descriptions for a given commodity (see, in particular, column 5, line 57, to column 6, line 13); and, associating 50 a selected account/description tuple with company commodity groups for use in a requisition creation process (see, in particular, column 6, lines 64-67), but Gardner et al. do not specifically disclose that the chart of accounts includes descriptions, nor that the valid accounts have a limited purchase period, nor presenting to the requisitioner a financial worksheet with valid general ledger account numbers and descriptions for selection by the requisitioner.

However, descriptions and valid periods (such as a name of the account and a particular valid fiscal year) for accounts are well known, hence obvious, elements to include in any system of requisitioning accounting so that the users know for what purpose each account is intended, or, in other words, providing a “mapping” or concordance between valid account codes/numbers and particular corresponding commodities/codes.

Likewise, presenting accounting data comprising charts of accounts in the form of a financial worksheet with valid general ledger account numbers and descriptions for selection by the requisitioner, is certainly well known, hence obvious, step to follow in the field of accounting.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Gardner et al., so as to include account descriptions and periods, as is well known to do, in order to facilitate selection of the proper account to which

to charge a particular requisition, and to present to the requisitioner a financial worksheet with valid general ledger account numbers and descriptions for selection by the requisitioner, as is also well known to do, doing so simply as a matter of design choice, since making such modifications could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 2, 16, and 18, the method of Gardner et al. includes the requisitioner 18 searching 40 against commodities and catalogs 24, 26, 28 in commodity description documents and, responsive thereto, creating one or more line items (see col. 5, line 61, to col. 6, line 13).

Regarding claims 3, 17, and 19-23, the method of Gardner et al. includes the requisitioner initiating a proceed to accounting process which displays lines item(s) selected by the requisitioner and an agent created financial worksheet (see, in particular, column 6, line 27, to column 9, line 56). Gardner et al. also disclose the use of commodity codes (see, in particular, column 5, lines 57-61), but do not specifically disclose the recited details of the descriptions of each commodity code. However, the recited elements of the commodity code descriptions are all well known, hence obvious, elements to use in any commodity code descriptions. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of Gardner et al., if required, so as to include the particular non-functional descriptive material recited by the claim, in order to describe each particular commodity code in detail so as to facilitate selection of the proper commodity code, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

***Response to Arguments***

10. Applicant's arguments filed November 2, 2004 have been fully considered but they are not persuasive.

11. Regarding the argument that the instant invention represents an improvement over the prior art, even an ingenious application of known principles to known problem by use of devices already known and understood to produce predictable result does not amount to invention. Moreover, the fact that an invention may produce a more efficient and more economical method of accomplishing result does not constitute invention. *Barrott et al. v. The Drake Casket Company*, 127 USPQ 69.

12. Regarding the argument that the failure of applicant to seasonably traverse the examiner's stated positions as to what is well known prior art does not result in the objects of the well known statements being therefore deemed and considered henceforth to be admitted prior art, failure of applicant to seasonably traverse the examiner's stated positions as to what is well known prior art indeed results in the objects of the well known statements being therefore deemed and considered henceforth to be admitted prior art. See MPEP §2144.03. If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 60 USPQ 239 (CCPA 1943).

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

December 13, 2004



Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627